Decision for dispute CAC-UDRP-101209

Case number	CAC-UDRP-101209
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Domain names	worldtradecenter.com, worldtradecenter.net

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	World Trade Centers Association, Inc.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Organization	Earth Plaza

IDENTIFICATION OF RIGHTS

The Complainant is the holder of trademark registrations consisting of the sign WORLD TRADE CENTER in multiple countries, including U.S. trademark registration no. 1469489 for the word mark “WORLD TRADE CENTER”, registered with the USPTO on December 15, 1987, in class 42 (hereinafter, the “WORLD TRADE CENTER trademarks”.

FACTUAL BACKGROUND

The Complainant is a not-for-profit corporation, incorporated in the State of Delaware on August 22, 1969. It aims at the stimulation of trade and investment opportunities for commercial property developers, economic development agencies, and international businesses looking to connect globally and prosper locally.

The disputed domain name <worldtradecenter.com> was registered on November 2, 1996. The disputed domain name <worldtradecenter.net> was registered on May 12, 1998. The disputed domain names currently do not resolve to an active webpage. For an undefined period of time, the first disputed domain name <worldtradecenter.com> has been used to link to a memorial page for the 9/11 attacks in 2001. It is uncontested that the disputed domain name has also been used as a parking page containing pay-per-click advertisements and that the second disputed domain name <worldtradecenter.net> redirected immediately to the first disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain names to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain names. According to the Complainant, the Respondent does not use the disputed domain names in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the disputed domain names. Finally, the Complainant considers that the disputed domain names were registered and are being used in bad faith.

RESPONDENT:

The Respondent argues that it makes legitimate noncommercial or fair use of the disputed domain names. According to Respondent, the disputed domain names were used for non-profit, humanitarian purposes only. After the events of September 11th, a humanitarian web page was linked to the disputed domain name <worldtradecenter.com> to help with rescue efforts. In 2006, after two years of development, the website was relaunched as a non-profit memorial tribute site.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Names are identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel notes that a privacy service was used with regard to the disputed domain name <worldtradecenter.com>. The Complainant states that it is entitled to proceed against both disputed domain names as these are registered by the same registrant. This has been confirmed after verification by the registrar.

Therefore, the Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:
1. The domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
2. The Respondent has no rights or legitimate interests in respect of the domain names; and
3. The domain names have been registered and are being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

Confusing similarity of the Domain Name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since Complainant is the holder of the WORLD TRADE CENTER trademarks, which are used in connection with its business, it is established that there is a trademark in which Complainant has rights.
The Panel considers the disputed domain names <worldtradecenter.com> and <worldtradecenter.net> to be composed of a name identical to the WORLD TRADE CENTER trademarks.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent. (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).)

The Panel notes that the Respondent has not been commonly known by the domain names and that the Respondent has not acquired trademark or service mark rights. Respondent's use and registration of the disputed domain names was not authorized by the Complainant. There are no indications that a connection between Complainant and Respondent existed.

The Respondent states that the disputed domain names were used for non-profit, humanitarian purposes only. While the Panel notes that the disputed domain name <worldtradecenter.com> has indeed been used to refer to a humanitarian web page and to a non-profit memorial tribute site, the Respondent does not contest the fact that it recently referred to a parking page containing sponsored links. Moreover, it appears from previous correspondence between the parties that the Respondent was aware of the Complainant's trademark rights since 1996.

In the circumstances of this case, the Panel is of the opinion that Respondent is not making a legitimate non-commercial or fair use of the disputed domain names. The Panel therefore concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Policy Paragraph 4(b) provides a non-exclusive list of factors, any one of which may demonstrate bad faith registration and use, namely:
(i) circumstances indicating that the domain name is registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name (Policy Paragraph 4(b)(i));
(ii) the registration of a domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct (Policy Paragraph 4(b)(ii));
(iii) the registration of a domain name primarily for the purpose of disrupting the business of a competitor (Policy Paragraph

4(b)(iii)); and
(iv) the use of a domain name for intentionally attempting to attract, for commercial gain, Internet users to a web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s web site or location or of a product or service on Respondent’s web site or location (Policy Paragraph 4(b)(iv)).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant’s trademark rights at the time of registration can evidence bad faith (See BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007).

In the present case, the Respondent claims to have discovered the Complainant’s trademark rights shortly after having registered the disputed domain name <worldtradecenter.com>. In view of the fact that the Complainant’s U.S. trademark was registered almost ten years before the disputed domain name <worldtradecenter.com>, the Panel finds that the Respondent must have known the Complainant’s trademarks before registering this domain name. The Respondent was unquestionably aware of the Complainant’s trademarks when registering the second disputed domain name <worldtradecenter.net> more than one year later.

Moreover, the Respondent’s subsequent use of the disputed domain names has clearly been targeting the Complainant’s WORLD TRADE CENTER trademarks. The Respondent does not contest that the disputed domain names recently referred to a parking page containing sponsored links, including links to websites which promotes third party services that compete with those of Complainant.

The Panel considers that the Respondent is using the domain names in bad faith, as the Respondent is using the Complainant’s WORLD TRADE CENTER trademarks in an attempt to attract Internet users with an apparent intent of commercial gain.

Considering the above, the Panel finds that the Complainant has made out the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **WORLDTRADECENTER.COM**: Transferred
2. **WORLDTRADECENTER.NET**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2016-06-14

Publish the Decision